

### **REMARKS**

Favorable reconsideration, reexamination, and allowance of the present patent application are respectfully requested in view of the foregoing amendments and the following remarks.

#### **Obviousness-type Double Patenting Rejections**

In the Office Action, beginning at page 3, Claims 27, 38, and 50 were rejected under the judicially-created doctrine of obviousness-type double patenting as reciting subject matters that are allegedly not separately patentable over the subject matters recited in Claims 1, 4, 7, 11, and 16 of the '*967 patent* (previously of record), in view of U.S. Patent No. 5,922,020, issued to Klein *et al.* ("Klein"). Additionally, Claims 57-60 and 62 were provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as reciting subject matters that are allegedly not separately patentable over the subject matters recited in Claims 43 and 46-48 in U.S. application number 10/231,007 ("'*007 application*"), in view of *Klein*. Applicant respectfully requests reconsideration of these rejections.

Once again, the Office Action has focused on what the '*967 patent* and the '*007 application* "disclose", rather than what they claim. For precisely the same reasons as presented in Applicant's prior Amendment, these double patenting rejections are thus fatally flawed and must be withdrawn.

The double patenting rejection's explanation, with respect to the '*967 patent*, does make reference to "Claim 1" and "Claim 11" which, because Claims 1 and 11 in this application have been cancelled, appear to be references to Claims 1 and 11 of the '*967 patent*. Mysteriously, however, the Office Action points to line numbers of those claims that do not exist: Claim 1 of '*967 patent* includes 20 lines; Claim 11 includes 18 lines. Claim 16 of the '*967 patent* is not mentioned at all, even though the Office Action alleges double patenting over its claimed subject matter. While a modicum of reference to the specification underlying a patented claim is appropriate (M.P.E.P. § 804(II)(b)(1)) to understand what the claim's terms mean, it is the claim's subject matters that are the focus of the analysis, and not the patent's disclosure.

The double patenting rejection's explanation, with respect to the '*007 application*, are yet

more deficient, not even attempting to reference the '*007 application*'s claimed subject matters, and is therefore as deficient as were the double patenting rejections in the Office Action dated 15 November 2005.

Setting aside these fundamental deficiencies in the Office Action, the Office Action would appear to allege that the differences between the subject matters recited in certain of this application's claims and those recited in certain of the '*967 patent*'s and the '*007 application*'s claims, would have been obvious to a person of ordinary skill in the art at the time of applicant's invention, in view of *Klein*, and thus issuing the claims in this application would allegedly result in an improper extension of the patent rights granted (with respect to the '*967 patent*) or to be granted (with respect to the '*007 application*) to Applicant.

Applicant discusses herein, with respect to rejections of some of the pending claims over *Klein* (*see infra*), many differences between *Klein*'s devices and those described and claimed in this and the '*967 patent* and the '*007 application*. Among these differences is the simple fact that *Klein*'s hinges and beams are oriented differently than Applicant's, which results in significantly different statics and dynamics of the expandable devices. More specifically, *Klein* describes only hinges which are curved along their widths, and not along their lengths. Thus, assuming *arguendo* that the ordinarily skilled artisan would somehow be motivated to look to *Klein* to modify the subject matters recited in the particular claims of '*967 patent* and the '*007 application*, the only guidance that *Klein* might supply is to curve a hinge circumferentially. In addition to producing a truly bizarrely shaped hypothetical hinge, the resulting combination would still not be read on by the combinations recited in the claims of this application.

Accordingly, in addition to the gross deficiencies in the rendering of the Office Action's double patenting rejections, allowance of the claims of this application would still not result in an impermissible extension of the patent rights in the '*967 patent* and the '*007 application*.

For at least the foregoing reasons, Applicant respectfully submits that the subject matters of Claims 27, 38, and 50 are separately patentable over the subject matters of Claims 1, 4, 7, 11, and 16 of the '*967 patent*, and that the subject matters of Claims 57-60 and 62 are separately patentable over the subject matters of Claims 43 and 46-48 in the '*007 application*, and therefore

respectfully requests withdrawal of the rejection thereof.

### **Objection to the Claims**

At page 5 of the Office Action, Claims 38, 50, and 57 were objected to because they allegedly are confusing. Applicant respectfully requests reconsideration of this objection.

Applicant twice endeavored to explain the meaning of the particular phrase identified in the Office Action, in the Personal Interview conducted on 6 April 2006 and in the subsequent Amendment filed 24 April 2006. In an effort to further explain the meaning of the clause, Applicant has added the phrase “from an initial dimension”, to assist the examiner in evaluating the starting point for evaluating stress and strain, as indicated in the claims. While Applicant believes that the original phraseology would have been understood by the ordinarily skilled routineer when reading this application, the addition of the foregoing phrase drives home the point.

For at least the foregoing reasons, Applicant respectfully submits that Claims 38, 50, and 57 are not objectionable, and therefore respectfully requests withdrawal of the objection thereto.

### **Rejection under 35 U.S.C. § 102**

In the Office Action, beginning at page 6, Claims 27, 30, 32-34, 36-41, 44, 46-48, and 50-55 were rejected under 35 U.S.C. § 102, as reciting subject matters that allegedly are anticipated by *Klein*. Applicant again respectfully requests reconsideration of this rejection.

Claim 27 relates to an expandable medical device having a combination of elements including, *inter alia*, each beam defining a width in the circumferential direction of the cylindrical device, and a plurality of ductile hinges connecting the plurality of beams together in the substantially cylindrical device, each hinge defining a width in the circumferential direction of the cylindrical device, a thickness, and a length, wherein the hinge width is smaller than the beam width.

Claim 38 relates to an expandable medical device having a combination of elements including, *inter alia*, each beam defining a beam width in the circumferential direction of the

cylindrical device, and a plurality of ductile hinges connecting the plurality of beams together in the substantially cylindrical device, each hinge defining a hinge width in the circumferential direction of the cylindrical device, wherein the hinge width is smaller than the beam width.

Claim 50 relates to an expandable medical device having a combination of elements including, *inter alia*, a plurality of elongated beams each defining a beam width in the circumferential direction of the cylindrical device, the plurality of elongated beams joined together to form a substantially cylindrical device which is expandable from a first diameter to a second diameter, and a plurality of ductile hinges connecting the plurality of beams together in the substantially cylindrical device, each hinge defining a hinge width in the circumferential direction of the cylindrical device and having first and second side surfaces, wherein the hinge width is smaller than the beam width.

The prior art, including *Klein*, fails to identically disclose or describe devices having combinations of elements as recited in the pending claims.

Applicant has, in the Personal Interview and the Amendment filed April 24<sup>th</sup>, described in detail aspects of the present invention, and how it is that *Klein* does not anticipate the claimed subject matter. Applicant will therefore not further burden the record with redundant

summaries, instead focusing on further failings of *Klein's* device.

Applicant has again reproduced *Klein's* Fig. 7a herein, annotated, to assist in a better understanding of *Klein's* device. One of the many fundamental differences between *Klein's* device and that recited in the pending claims, is the position of the hinges 36 relative to the struts 32. In *Klein's* device, the hinge portion 42 extends generally circumferentially and thus has a

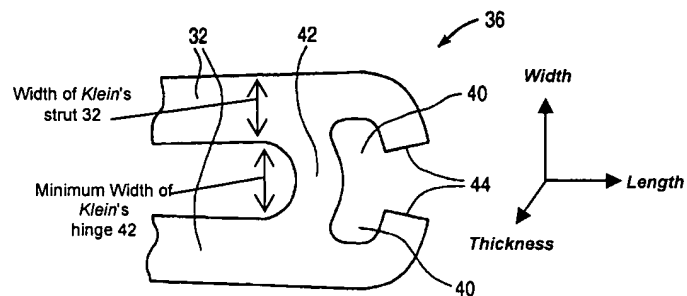


FIG. 7A

*Klein* Fig. 7a,  
annotated

large width, as that term is used in the claims of this application. Thus, as illustrated herein, the minimum possible width (which is taken in the circumferential direction) of *Klein*'s hinge portion 42 is slightly larger than the width (again, taken in the circumferential direction) of *Klein*'s strut 32. While *Klein* does not recognize the importance of such a relationship, as did the inventor herein, even measuring directly off of Fig. 7a of *Klein* confirms this conclusion: *Klein*'s hinge's width is at least as large as the strut's width.

For at least the foregoing reasons, Applicant respectfully submits that the subject matters of Claims 27, 30, 32-34, 36-41, 44, 46-48, and 50-55 are not anticipated by *Klein*, are therefore not unpatentable under 35 U.S.C. § 102, and therefore respectfully requests withdrawal of the rejection thereof under 35 U.S.C. § 102.

#### **Rejection under 35 U.S.C. § 103(a)**

In the Office Action, beginning at page 8, Claims 28, 29, 31, 35, 42, 43, 45, 49, and 56-65 were rejected under 35 U.S.C. § 103(a), as reciting subject matters that allegedly are obvious, and therefore allegedly unpatentable, over *Klein* alone, or in hypothetical combination with *Kusleika*, *MacGregor*, or U.S. Patent No. 6,273,908, issued to Ndondo-Lay. Applicant respectfully requests reconsideration of this rejection.

Claim 57 relates to a an expandable medical device having a combination of elements including, *inter alia*, ductile hinges asymmetrically configured to reach a predetermined strain level upon a first percentage of expansion from an initial dimension and to reach the predetermined strain level upon a second percentage of compression from said initial dimension, the first percentage being larger than the second percentage.

The prior art, including, *Klein*, *Kusleika*, *MacGregor*, and *Ndondo-Lay*, fails to identically disclose or fairly suggest the subject matters of the pending claims.

*Klein*, *Kusleika*, and *MacGregor* fail to make up for the deficiencies of *Klein* alone with respect to the subject matters of Claims 28, 29, 31, 35, 42, 43, 45, and 49, at least because none disclose, describe, or suggest proportioning the widths of hinges and struts in combination with the remaining features recited in these claims.

Concerning Claim 57, one result of the claimed hinge configuration, as compared to that of *Klein*, is that the claimed hinges are able to generate much more plastic deformation for a set amount of expansion of the device (*e.g.*, as expressed as a percentage of a complete total expansion of the device from an initial dimension) which, as explained in great depth and detail in this specification, can greatly assist in reducing elastic recoil and permits advantageous dimensioning of the hinges. *Klein*'s configuration of hinges does not benefit from the characteristic recited in the claims; merely because the left side surface (Fig. 7a of *Klein*) of hinge portion 42 is in tension during expansion, and in compression during compression, of *Klein*'s device, does not *ipso facto* require that *Klein*'s device reach a predetermined strain level upon a first percentage of expansion from an initial dimension and to reach the predetermined strain level upon a second percentage of compression from that initial dimension, with first percentage being larger than the second percentage. *Ndondo-Lay* fails to make up for this deficiency in *Klein* as well.

For at least the foregoing reasons, Applicant respectfully submits that the subject matters of Claims 28, 29, 31, 35, 42, 43, 45, 49, and 56-65, each taken as a whole, would not have been obvious to one of ordinary skill in the art at the time of Applicant's invention, are therefore not unpatentable under 35 U.S.C. § 103(a), and therefore respectfully requests withdrawal of the rejection thereof under 35 U.S.C. § 103(a).

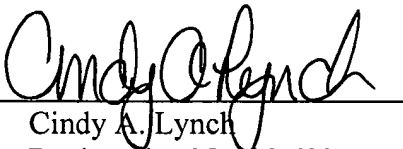
## **Conclusion**

Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of this patent application is therefore respectfully solicited.

If Ms. Houston believes that a telephone conference with the undersigned would expedite passage of this patent application to issue, she is invited to call on the number below.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. If, however, additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and the Commissioner is hereby authorized to charge fees necessitated by this paper, and to credit all refunds and overpayments, to our Deposit Account 50-3100.

Respectfully submitted,

By:   
Cindy A. Lynch  
Registration No. 38,699

**U.S. P.T.O. Customer Number 43027**  
Conor Medsystems, Inc.  
1003 Hamilton Court  
Menlo Park, CA 94025  
650.614.4131 (v)

Date: November 13, 2006